

REMARKS

At the time of the Office Action dated April 21, 2005, claims 1-22 were pending. Applicants acknowledge, with appreciation, the Examiner's indication that claims 4-6 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants also acknowledge, with appreciation, the Examiner's indication that claim 11 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and overcoming the 35 U.S.C. §112, second paragraph rejection. The Office Action Summary suggests that claims 9 and 14 have been objected to. However, the Office Action provides no ground of objection and rejection of those claims. Therefore, Applicants presume that claims 9 and 14 would be allowable if written in independent form.

In this Amendment, claims 1-12, 14 and 16-22 have been amended, and new claims 23 and 24 added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the amendment of claims 1, 7, 8 and 11 should be apparent throughout the originally filed disclosure as, for example, the depicted embodiments and related discussion thereof in the written description of the specification. Claims 2-6, 9, 10, 12, 14 and 16-22 have been amended to improve wording. New claims 23 and 24 were prepared based on the combination of claims 1, 3 and 4, and the combination of claims 1, 3 and 5, respectively.

Specification.

The Examiner has objected to the abstract because of informalities. In response, the abstract has been amended thereby overcoming the stated bases for the objection to the abstract. Withdrawal of this objection is, therefore, respectfully solicited.

Claim Objections.

Claim 12 has been objected to because of informalities. In response, claim 12 has been amended in a manner suggested by the Examiner. Applicants, therefore, respectfully solicit withdrawal of the objection to claim 12.

Claims 7, 8 and 11 have been rejected under 35 U.S.C. §112, second paragraph.

With respect to claims 7 and 11, the Examiner asserted, “it is unclear regarding what Applicant is claiming in reference to ‘straight line passing.’ Applicant does not make reference to this limitation in the Specification” (paragraph 4 of the Office Action). In response, claims 7 has been amended to recite “a straight line passing through two probable edge points,” and claim 11 has also been amended to recite “a straight line passing through a document edge point.” Applicants invite the Examiner’s attention to the paragraph on page 18, lines 21-28 of the specification where the “straight line” is described.

The Examiner further pointed out that there is insufficient antecedent basis for the limitation “the object probable edge point” in claim 8. In response, claim 8 has been amended to obviate the antecedent basis issue.

Therefore, Applicants respectfully solicit withdrawal of the rejection of claims 7, 8 and 11 under 35 U.S.C. §112, second paragraph, and favourable consideration thereof.

Claims 1, 2, 7, 8, 10, 12, 13, 15-20 and 22 have been rejected under 35 U.S.C. §102(b) as being anticipated by Sugiura.

In the statement of the rejection, the Examiner asserted that Sugiura discloses an image reader with a platen criterial mark for determining a document scan start identically corresponding to what is claimed. This rejection is respectfully traversed.

It is well established precedent that the factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *See EMI Group N. Am., Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342, 60 USPQ2d 1423 (Fed. Cir. 2001); *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

It is submitted that there are significant differences between the claimed invention and Sugiura's image reader that defeat the factual determination that Sugiura identically describes the claimed invention within the meaning of 35 U.S.C. §102.

Sugiura, in column 5, lines 57-59, and column 6, lines 24-26, describes detecting an image area of an original document by cutting only the image area from the document. For such purpose, Sugiura's reader detects a white level (image area) and a black level (non-image area) (see column 6, lines 29-31).

On the other hand, an image reading apparatus in claim 1 and a processing apparatus in claim 22 are configured for detecting a contour of a document itself on a glass plate (see, e.g., document table 102 in Fig. 1 of the present application). In particular, the claimed invention makes it possible to detect the document contour even in the case of copying an original document in a sky-shot mode (see page 1, lines 11-13 of the specification, for the sky-shot mode). When a sensor reads an original document on the glass plate in the sky-shot mode, the

density obtained from the document contour is not apparently distinguished from the density obtained from a glass plate area (including a projection area, see 103 in Fig. 1 of the present application) not covered by the original document, as described in the background section of the specification.

If Sugiura were applied to the claimed invention, the sensor would be expected to recognize the glass plate area (the projecting area) to be black (non-image area) and the original document to be white (image area). However, in the sky-shot mode, the density obtained from the glass plate area (the projecting area) has a specific level due to the skylight. Accordingly, since the glass plate area (the projecting area) is not properly recognized to be black in the sky mode, it is not possible to detect the document contour in Sugiura's image reader. Unlike Sugiura's apparatus, the claimed invention is configured to detect a density difference between pixels (the density change) in order to recognize the document contour.

The above-described fundamental differences between the claimed invention and Sugiura undermine the factual determination that Sugiura identically describes the claimed invention within the meaning 35 U.S.C. §102. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicants, therefore, submit that the imposed rejection of independent claims 1 and 22 under 35 U.S.C. §102(b) for lack of novelty as evidenced by Sugiura is not factually viable and, hence, solicit withdrawal thereof.

Further, it is submitted that dependent claims 2, 7, 8, 10, 12, 13 and 15-20 are also patentably distinguishable at least because they include all the limitations recited in independent

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claim 1. Withdrawal of the rejection of claims 2, 7, 8, 10, 12, 13 and 15-20 is respectfully solicited.

Claim 3 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Sugiura in view of Houjiyou et al; and claim 21 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Sugiura in view of Migita et al.

For the reasons set forth above, independent claim 1 is patentable because Sugiura does not disclose all the limitations recited in claim 1. It is also submitted that neither Houjiyou et al. nor Migita et al. teaches or suggests an image reading apparatus including all the limitations recited in claim 1. Thus, the applied combinations of the references do not teach or suggest an image reading apparatus including all the limitations recited in claims 3 and 21 at least because those claims include all the limitations recited in independent claim 1.

Since the pending rejection has not established *prima facie* obviousness of the claimed invention as recited in claims 3 and 21, Applicants respectfully solicit withdrawal of the rejection of those claims and favorable consideration thereof.

Conclusion.

It should, therefore, be apparent that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

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including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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Recognition under 37 C.F.R. 10.9(b)

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